

REMARKS

In the Office Action, the Examiner required restriction, under 35 U.S.C. 121, to one of the following inventions:

- I. Claims 1-19, drawn to an electrostatic dissipating laminate, classified in class 442, subclass 1.
- II. Claims 20-22, drawn to a method of making an electrostatic dissipating laminate, classified in class 427, various subclasses.

Applicant hereby elects invention I with traverse. Applicant respectfully disagrees with the Examiner's requirement of restriction in the present application. More particularly, applicant avers that the distinction which the Examiner draws between invention I and invention II is strained. The Examiner states that "the cellulose-based structure may be drawn through the polymer resin." Claim 20 provides, in relevant part, that "...the improvement comprises adding a conductance modifying component selected from the group consisting of an inherently conductive polymer, a conductive nanophase material and mixtures thereof to said laminate structure by...forming an aqueous dispersion of said conductance modifying component and applying said aqueous dispersion to said hard laminate structure." In Claim 20, applicant does not make a distinction as to how the conductance modifying component is applied to the laminate structure. One method of applying the conductance modifying component could encompass drawing the cellulose-based structure through the polymer resin. In contrast to the Examiner's statement, applicant avers that such a process is inherently included in Claim 20 and that it is not a distinct invention. Therefore, applicant respectfully requests removal of the restriction requirement.

The Examiner then rejected Claims 2, 4, 5, 8, and 11 under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, applicant has amended Claim 2 by replacing "formaldehyde-type" with --formaldehydes--. Applicant additionally has amended Claims 4 and 5 to disclose how the treatment impacts the final laminate structure to be instantly claimed. Finally, applicant has amended Claims 8 and 11 to more particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 1-5, 13, 15, 16, and 19 under 35 U.S.C. 102(e) as being anticipated by Yeager et al. (PG Pub 2001/0053820). Applicant respectfully requests reconsideration and removal of this ground of rejection. More particularly, applicant avers that the subject matter of the rejected Claims was invented prior to the earliest effective date of the Yeager reference. In support, applicant is submitting an affidavit under 37 C.F.R. 1.131 with exhibits which establishes conception of the invention before the effective date of the Yeager reference. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 1, 2, 3, 5, 12, and 17 under 35 U.S.C. 102(b) as being anticipated by Dzenis et al. (US 6,265,333). Applicant respectfully requests reconsideration and removal of this ground of rejection. Applicant avers that the Examiner has misconstrued the disclosure of the Dzenis reference.

More particularly, applicant agrees with the Examiner that “Dzenis et al. disclose a fiber reinforced composite material comprising a resin matrix and reinforcing fibers...The fibers included in the applied invention provide interlaminar toughness, strength, and delamination resistance.” However, applicant’s invention is not directed toward increasing toughness, strength, or resistance: “The present invention provides improved electrostatic charge dissipating hard laminates...” (Abstract).

Additionally, due to the claimed composition, the electrostatic dissipating laminate structure of the present application is capable of meeting ESD S4.1 (“ESD Association Standard for the Protection of Electrostatic Discharge Susceptible Items--Worksurfaces--Resistance Measurements) and ESD STM4.2 (“ESD Association Standard for the Protection of Electrostatic Discharge Susceptible Items--Worksurfaces--Charge Dissipation Characteristics”) down to 10% relative humidity. The structure disclosed by the Dzenis reference, however, does not disclose, teach, or suggest how to meet the ESD S4.1 and ESD STM4.2 standards. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claim 18 under 35 U.S.C. 103(a) as being unpatentable over Dzenis et al. Applicant respectfully requests reconsideration and

removal of this ground of rejection. More particularly, applicant agrees with the Examiner's assertion that "where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233." However, as discussed above, the general conditions of applicant's claim are *not* disclosed in the prior art. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 1-7 and 13-15 under 35 U.S.C. 102(b) as anticipated by Majumdar et al. (US 6,025,119). In response, applicant has amended Claim 1 to more particularly define that which applicant regards as the invention. Majumdar teaches "an electrical resistivity of less than 12 log ohms/square in relative humidity of from 50%-5, but preferably less than 11 log ohms/square, and more preferably 10 log ohms/square." (Col. 6, lines 25-28). Claim 1, as amended, specifically claims a point-to-point resistance of 10^6 to 10^9 ohms when tested in accordance with ESD S4.1. This does not constitute new matter and finds support in the specification at, *inter alia*, page 5, lines 6-7. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 1-8 and 17 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakajima et al. (US 6,261,995). In response, applicant has amended Claim 1 to more particularly define that which applicant regards as the invention. Nakajima teaches that a surface specific resistance of not more than 2×10^9 ohms is insufficient to "prevent static charge occurring in transportation". (Col. 1, lines 46-49). Therefore, Nakajima teaches the use of a surface specific resistance that "is more than 2×10^9 to not more than 10^{12} ohms/m²," (Col. 2, lines 54-55). In contrast, amended Claim 1 specifically claims a point-to-point resistance in the range of 10^6 to 10^9 ohms when tested in accordance with ESD S4.1. Therefore, Nakajima has not disclosed the claimed subject matter.

Additionally, it would not have been obvious to one of ordinary skill in the art to modify the disclosure of Nakajima so as to create that which applicant claims as the invention. As noted above, Nakajima specifically taught away from using any resistance that measures less than 2×10^9 ohms. (Col. 1, lines 46-49). This is precisely what

applicant has claimed in the amended Claim 1. Therefore, applicant respectfully requests removal of these grounds of rejection.

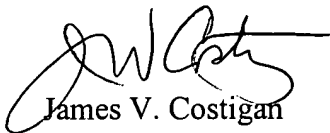
The Examiner then rejected Claims 1-3, 9-11, and 17 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Follensbee et al. (US 6,239,049). In response, applicant has amended Claim 1 to more particularly define that which applicant regards as the invention. Follensbee teaches the use of “materials useful for dissipating static charges such as carbon black and graphite”. (Col. 8, lines 45-46). In contrast, amended Claim 1 specifically claims a point-to-point resistance in the range of 10^6 to 10^9 ohms when tested in accordance with ESD S4.1. Follensbee has not disclosed the range of resistance values which applicant has claimed.

Additionally, the invention of Follensbee pertains to “a composition for use in coated abrasives.” (Abstract). It would not have been obvious to one of ordinary skill in the art to modify the disclosure of Follensbee so as to create that which applicant claims as the invention, because there is no suggestion or motivation in Follensbee to modify its teachings in such a way. The limited suggestion that carbon black and graphite, which are materials useful for dissipating static charges, be used is made because Follensbee considers it to be a “known and compatible additive useful in coatings in the abrasives art.” (Col. 8, lines 40-46). One of ordinary skill in the abrasives art would not be the same person as one of ordinary skill in the static dissipating art. Additionally, the problems which the two inventions solve are different. Follensbee is intended to “provide[] a treated substrate for an abrasive article.” (Col. 1, lines 66-67). In contrast, the present invention “provides improved electrostatic charge dissipating hard laminates.” (Abstract). Therefore, applicant respectfully requests removal of these grounds of rejection.

In light of the foregoing applicant respectfully submits that that the claims of the present application are in proper form for allowance.

An early and favorable action is earnestly solicited.

Respectfully submitted,



James V. Costigan
Reg. No. 25,669

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
212-302-8989